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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/855,867	05/14/2001	Bruce Hogue Penrod		1182

7590 09/12/2003

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EXAMINER
LU, KUEN S

ART UNIT	PAPER NUMBER
2177	

DATE MAILED: 09/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/855,867	PENROD ET AL.	
	Examiner	Art Unit	
	Kuen S Lu	2177	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 May 2001* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-13* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-13* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Drawings

The drawings are objected to because they fail to show necessary textual labels of features or symbols in Fig. 1-4 as described in the specification. For example, placing a label "public web site", with element 140 of Fig. 1, would give the viewer necessary detail to fully understand this element at a glance. A **descriptive** textual label for **each numbered element** in these figures would be needed to fully and better understand these figures without substantial analysis of the detailed specification. Any structural detail that is of sufficient importance to be described should be shown in the drawing. Optionally, applicant may wish to include a table next to the present figure to fulfill this requirement. See 37 CFR 1.83. 37 CFR 1.84(n)(o) is recited below:

"(n) Symbols. Graphical drawing symbols may be used for conventional elements when appropriate. The elements for which such symbols and labeled representations are used must be adequately identified in the specification. Known devices should be illustrated by symbols which have a universally recognized may be used, subject to approval by the Office, if they are not likely to be confused with existing conventional symbols, and if they are readily identifiable."

"(o) Legends. Suitable descriptive legends may be used, or may be required by the Examiner, where necessary for understanding of the drawing, subject to approval by the Office. They should contain as few words as possible."

Abstract

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology

often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc. In this case, "The invention disclosed" is recited.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 2, 5-10 and 12 are rejected under 35 U.S.C. 102(e) as anticipated by Castor et al. (U.S. Patent 6,246,797).

Castor teaches the limitations of claim 2 by the following:

"creating one or more digital image files of artwork" at col. 3, lines 59-67;

"transmitting the digital image file" and "transmitting the grouping of digital image files" at Fig. 10, elements 300-320, col. 14, lines 53-65;

"collecting the digital image file" at col. 4, lines 28-32 and col. 9, lines 26-28;

"accepting or rejecting the digital image file" at col. 4, lines 62-67;

"compiling the accepted digital image files to form a grouping" at col. 5, lines 20-30 and col. 15, lines 14-31; and

"displaying the grouping" at col. 2 lines 17-22 and col. 15, lines 10-12.

As per claim 5, Castor teaches "...takes a digital photo or scans a picture to create the digital image file" at col. 8, lines 56-58.

As per claims 6 and 8, Castor teaches "...grouping is transmitted over Internet" and "...grouping is transmitted over Internet to remote locations" at col. 14, lines 53-65.

As per claim 7, Castor teaches "...the grouping is transmitted by making a cd-rom or dvd of the grouping and physically transferring the cd-rom or dvd" at col. 14, lines 34-38.

As per claims 9 and 10, Castor teaches "...digital image is transmitted to a collection web site" or "...displayed on a public web site" at Fig. 10, elements 300-320, col. 14, lines 53-65.

As per claim 12, Castor teaches "...grouping is displayed on a personal computer" at col. 15, lines 10-12.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Castor et al. (U.S. Patent 6,246,797) in view of Anderson (U.S. Pub. 2003/0122950).

Castor rendered obvious independent claim 1 by the following:

"...means to capture the image of artwork" at col. 3, lines 59-67;

"...to collect the images of the artwork" at col. 4, lines 28-32 and col. 9, lines 26-28;

"...to distribute the grouping..." at Fig. 10, elements 300-320, col. 14, lines 53-65; and "to display the grouping containing the images of..." at col. 2, lines 17-22 and col. 15, lines 10-12.

Castor does not specifically teach "using...means to sort those images into a grouping".

However, Anderson does at col. 4, [0046], lines 1-11 and 14-17.

It would have been obvious to one having ordinary skill in the art at the time of the applicant's invention was made to combine Anderson's reference with Castor's because both are devoted to capturing image and transforming it into digital data. The combination would have provided additional keys for sorting and grouping a collection of digital image files to users of Castor's system. The enhanced sorting and grouping practice would have made distribution of the image files on the web sites
or to the clients more manageable.

3. Claims 3, 4 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Castor et al. (U.S. Patent 6,246,797) as applied to claim 2 above, and further in view of Ball et al. (U.S. Pub. 2002/0161835).

As per claims 3, 4 and 13, Castor does not teach "...combining advertising files with the accepted digital image files into the grouping" or "...digital image files are jpeg and mpeg files", though Castor teaches jpeg format.

However, Ball teaches appending a data block to the image file for sending to the users at col. 5, [0088], lines 11-17 and jpeg and mpeg formats for data compression at col. 11, [0153], lines 7-13.

It would have been obvious to one having ordinary skill in the art at the time of the applicant's invention was made to combine Siefken's reference with Castor's because both are devoted to generate and distribute image sets. The combination of Siefken's reference with Castor's teaching would have further enhance the promotion and distribution of digital images through wider scope of displaying tools.

4. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Castor et al. (U.S. Patent 6,246,797) as applied to claim 2 above, and further in view of Siefken (U.S. Patent 6,433,839).

As per claim 11, Castor does not specifically teach using projector for displaying digital Image files, though other means are well utilized.

However, Siefken teaches techniques for storing images on films and playing back on projections at col. 4, lines 52-54.

It would have been obvious to one having ordinary skill in the art at the time of the applicant's invention was made to combine Siefken's reference with Castor's because both are devoted to generate and distribute image sets. The combination of Siefken's reference with Castor's teaching would have further enhanced the promotion and distribution of digital images through larger viewer audience because of using much larger displaying tools.

Conclusions

The prior art made of record

A. U.S. Pub. No. 2002/0161835

B. U.S. Patent No. 6246797

C. U.S. Patent No. 6433839

D. U.S. Pub. No. 2003/0122950

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

E. U.S. Patent No. 6426778

F. U.S. Pub. No. 2002/0080168

G. U.S. Patent No. 6580466

H. U.S. Pub. No. 2003/0041287

I. U.S. Pub. No. 2002/0166123

J. U.S. Pub. No. 2002/0144258

K. U.S. Patent No. 6338094

L. U.S. Pub. No. 2002/0154266

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuen S Lu whose telephone number is 703-305-4894. The examiner can normally be reached on 8 AM to 5 PM, Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene can be reached on 703-305-9790. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

KL

Patent Examiner

August 18, 2003

JOHN BREENE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100